

REMARKS

In the Final Office Action¹ of August 3, 2010 ("the Office Action"), the Examiner:

- (1) rejected claims 1, 3, 5-11, 14-16, 18, 25, 27, 29, 30, 32-37, and 39-46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,424,438 to Vianello (*Vianello*) in view of U.S. Patent No. 7,283,951 to Marchisio et al. (*Marchisio*), U.S. Patent Application Publication No. 2005/0086204 to Coiera (*Coiera*), and U.S. Patent Application Publication No. 2002/0052894 to Bourdoncle et al. (*Bourdoncle*);
- (2) rejected claim 17 under 35 U.S.C. § 103(a) over *Vianello* in view of *Marchisio*, *Coiera*, *Bourdoncle*, and U.S. Patent No. 6,636,837 to Nardozzi et al. (*Nardozzi*); and
- (3) rejected claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Vianello* in view of *Marchisio*, *Coiera*, *Bourdoncle*, and U.S. Patent No. 7,392,254 to Jenkins (*Jenkins*).

By this Amendment, Applicant amend claims 1, 7, 25, 33, 36, 41, 42, 44, and 46, and cancels claims 11 and 29 without prejudice or disclaimer of the subject matter thereof. Claims 2, 4, 12, 13, 21-24, 26, 28, 31 and 38 were canceled by previous amendment. Accordingly, upon entry of the above amendments, claims 1, 3, 5-10, 14-20, 25, 27, 30, 32-37, and 39-46 will remain pending in this application, including independent claims 1 and 25.

Applicant respectfully traverses the rejections and submits that the pending claims are allowable over the prior art of record for at least the following reasons.

I. Summary of Examiner Interview of December 21, 2010

¹ The Final Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

Applicant thanks the Examiner for taking the time to discuss the present application with Applicant's representatives on December 21, 2010. During the interview, Applicant's representatives addressed the outstanding rejections and highlighted the differences between the cited art and the pending claims. With respect to independent claim 1, several clarifying amendments were also discussed. Although no agreement was reached, the Examiner appeared to acknowledge that certain elements of amended claim 1, such as "automatically creating segments of the narrowed hit-list by grouping the resources according to one of a plurality of attribute dimensions," were not disclosed by the cited art. The Examiner, however, reserved any final judgment on the amended claims pending further consideration and/or search of the prior art.

In view of the foregoing, Applicant has prepared this Amendment and filed the same with a Request for Continued Examination so that the claims amendments will be fully considered and entered. Favorable consideration is requested and believed to be appropriate.

II. Rejection under 35 U.S.C. 103(a) Based on *Vianello* in view of *Marchisio*, *Bourdoncle*, and *Coiera*

Applicant respectfully traverses the rejection of claims 1, 3, 5-10, 14-16, 18, 25, 27, 30, 32-37, and 39-46 under 35 U.S.C. § 103(a) as being unpatentable over *Vianello* in view of *Marchisio*, *Bourdoncle*, and *Coiera*. A *prima facie* case of obviousness has not been established with respect to Applicant's claims.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections

on obviousness cannot be sustained with mere conclusory statements.” *M.P.E.P.*

§ 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” *M.P.E.P.* § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P.* § 2141(III). Here, no *prima facie* case of obviousness has been established for at least the reasons that the Office Action has not properly determined the scope and content of the prior art and has not properly ascertained the differences between the claimed subject matter and the prior art.

Independent claim 1, as amended, is directed to a method which includes, among other things:

searching, using a processor, the data source of resource profiles for profiles having one or more of the first attributes;

providing, to the user, a hit-list of resources having the one or more first attributes;

receiving one or more second attributes of the resource through a refinement user interface;

searching the hit-list for resources having the one or more second attributes;

providing, to the user, a narrowed hit-list of resources having the one or more first and second attributes;

automatically creating segments of the narrowed hit-list by grouping the resources according to one of a plurality of attribute dimensions.

In the Office Action, the Examiner concedes that *Vianello* does not disclose the claim language “providing, to the user, a narrowed hit-list of resources.” Office Action, p. 3. However, the Examiner relies on *Marchisio* and asserts that it discloses this subject matter of Applicant’s claims. This is incorrect.

Marchisio relates to a method of applying user preferences for searches, according to which a user may designate attribute values that are used as filters by a Syntactic Query Engine when performing queries. See *Marchisio*, col. 12, ll. 13-42; Fig. 15. However, *Marachisio*’s user preferences for searches do not disclose or suggest “**providing, to the user, a hit-list of resources** having the one or more first attributes; receiving one or more second attributes of the resource through a refinement user interface; **providing, to the user, a narrowed hit-list of resources** having the one or more first and second attributes,” as recited in amended claim 1 (emphases added). At most, the Syntactic Query Engine of *Marchisio* merely uses preferences to limit the **one** result set. Indeed, *Marachisio* is silent with regard to providing an **initial result set** to the user **and** providing a **narrowed result set** to the user.

The Examiner argues *Marchisio* teaches the claimed subject matter since “preferences or second attributes... are used to filter or refine the result of a search (i.e. hit-list).” Office Action, p. 14. This is incorrect. Even assuming that *Marchisio*’s result set is akin to a “hit-list,” which Applicant does not concede, *Marchisio* only provides **one result set to the user**. The Syntactic Query Engine of *Marchisio* uses the preferences to **filter search results that are not provided to the user** and subsequently provides

one result set to the user. See *Marchisio*, col. 12, ll. 13-42; Fig. 15. Accordingly, *Marchisio* cannot teach or suggest “providing, to the user, a hit-list” and “providing, to the user, a narrowed hit-list,” as recited in claim 1. *Bordoncle* and *Coiera* fail to remedy the deficiencies of *Vianello* and *Marchisio* at least because *Bordoncle* and *Coiera* also fail to teach or suggest the above-identified features of independent claim 1, nor does the Office Action allege otherwise.

The asserted prior art also fails to disclose or suggest other elements of amended independent claim 1. For example, *Marchisio* and the other asserted references fail to teach or suggest “automatically creating segments of the narrowed hit-list by grouping the resources according to one of a plurality of attribute dimensions,” as recited by claim 1. In the Office Action, the Examiner concedes that *Vianello*, *Marchisio*, and *Bordoncle* do not disclose or suggest “creating segments.” Office Action, p. 5. However, the Examiner relies on *Coiera* and asserts that it discloses the claimed subject matter. Applicant respectfully disagrees.

Coiera relates to searching data stores in accordance with search templates. *Coiera*, ¶ [0038]. According to *Coiera*, a user begins by selecting a search profile to limit searches of the data stores. *Coiera*, ¶¶ [0038],[0058]. The search profile may include date restrictions, search duration, data sources to be searched, search subject, etc. *Coiera*, ¶¶ [0045]-[0052].

Once a search is completed in *Coiera*, the search results are listed along with a “summary of the search.” *Coiera*, ¶ [0063]; Fig. 9. In the summary, “[d]ocuments

coming from different sources are grouped together to represent main categories such as guidelines, journals, and text books.” See, *Id.*

Contrary to the assertions in the Office Action, *Coiera*’s “summary of the search” does not teach or suggest “automatically creating segments of [a] narrowed hit-list,” as recited in independent claim 1 (emphasis added). *Coiera* merely discloses a search providing **one result set**. *Coiera* is silent with regard to any narrowing of a search result set, let alone “automatically creating segments of [a] narrowed hit-list.” Accordingly, for at least this reason, *Coiera* does not overcome the acknowledged deficiencies of *Vianello*, *Marchisio*, and *Bourdoncle* with respect to independent claim 1.

Additionally, *Coiera*’s “summary of the search” does not constitute “automatically creating segments of the narrowed hit-list **by grouping the resources according to one of a plurality of attribute dimensions**,” as recited by claim 1 (emphasis added). *Coiera* discloses grouping documents **only by source** rather than “grouping according to **one of a plurality of attribute dimensions**,” as claimed. Each category of *Coiera*, i.e. guide-line, journal, and textbook, is merely a different discrete value of source, but the grouping step is done **only by source**. Accordingly, *Coiera* cannot disclose or suggest “automatically creating segments of the narrowed hit-list by grouping the resources according to **one of a plurality of attribute dimensions**,” as recited by claim 1 (emphasis added).

In view of the above, the Office Action has neither properly determined the scope and content of the prior art, nor ascertained the differences between the claimed subject matter and the prior art. Moreover, the Examiner has not identified any factors that

would have motivated one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combination. Accordingly, no reason has been clearly articulated as to why the prior art would have rendered independent claim 1 obvious to one of ordinary skill in the art. Therefore, a *prima facie* case of obviousness has not been established with respect to the claim and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Amended independent claim 25, while of different scope than independent claim 1, distinguish over *Vianello*, *Marchisio*, *Bourdoncle*, and *Coiera* for at least reasons similar to those noted above for claim 1. Thus, the rejection of independent claim 25 under 35 U.S.C. § 103(a) should also be withdrawn for reasons similar to those set forth above for independent claim 1.

Dependent claims 3, 5-10, 14-16, 18, 27, 30, 32-37, and 39-46 distinguish over *Vianello*, *Marchisio*, *Bourdoncle*, and *Coiera* at least due to their dependence from one of the allowable independent claims and further in view of the features recited in these claims. Furthermore, the rejection of claims 11 and 29 is moot in view of the cancellation of these claims.

Accordingly, Applicant requests reconsideration and withdrawal of the § 103(a) rejection based on *Vianello*, *Marchisio*, *Bourdoncle*, and *Coiera* and the timely allowance of the claims.

III. Rejection under 35 U.S.C. 103(a) Based on *Vianello* in view of *Marchisio*, *Bourdoncle*, *Coiera*, and *Nardozzi*

Applicant respectfully traverses the rejection of claim 17 under 35 U.S.C.

§ 103(a) over *Vianello* in view of *Marchisio*, *Coiera*, *Bourdoncle*, and *Nardozzi*. A *prima facie* case of obviousness has not been established with respect to claim 17.

Dependent claim 17 depends from allowable independent claim 1 and includes all recitations therein. As discussed, combinations of *Vianello*, *Marchisio*, *Coiera*, and *Bourdoncle* fail to teach or suggest all of the features of independent claim 1. *Nardozzi* fails to remedy the deficiencies of *Vianello*, *Marchisio*, *Coiera*, and *Bourdoncle* at least because *Nardozzi* also fails to teach or suggest the above noted features of claim 1. Accordingly, combinations of *Vianello*, *Marchisio*, *Coiera*, *Bourdoncle*, and *Nardozzi* fail to teach or suggest dependent claim 17, and this claim is allowable at least because of its dependence from claim 1, as well as in view of the additional features recited by this claim.

IV. Rejections under 35 U.S.C. 103(a) Based on *Vianello* in view of *Marchisio*, *Bourdoncle*, *Coiera*, and *Jenkins*

Applicant respectfully traverses the rejection of claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Vianello* in view of *Marchisio*, *Coiera*, *Bourdoncle*, and *Jenkins*. A *prima facie* case of obviousness has not been established with respect to claims 19 and 20.

Dependent claims 19 and 20 depend from allowable independent claim 1 and include all recitations therein. As discussed, combinations of *Vianello*, *Marchisio*, *Coiera*, and *Bourdoncle* fail to teach or suggest all of the features of claim 1. *Jenkins* fails to remedy the deficiencies of *Vianello*, *Marchisio*, *Coiera*, and *Bourdoncle* at least because *Jenkins* also fails to teach or suggest the above noted features of claim 1.

Accordingly, combinations of *Vianello, Marchisio, Coiera, Bourdoncle, and Jenkins* fail to teach or suggest dependent claims 19 and 20, and these claims are allowable at least because of their dependence from claim 1, as well as in view of the additional features recited by these claims.

CONCLUSION

In view of the foregoing, Applicant submits that the pending claims are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant, therefore, requests the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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